IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Marko VANSKA, et al.

Group Art Unit: 2143

Serial No.: 09/824,781

Examiner: Joseph E. AVELLINO

Filed: April 4, 2001

For: OPERATING USER PROFILES WITH DISTRIBUTED PROFILE MODEL
USING A HYBRID TERMINAL

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. 41.41, the Appellant submits this reply brief in

support of their appeal, in response to the Examiner's Answer dated December 14, 2007

(hereinafter "the Examiner's Answer"). The appeal is from the decision of the Examiner

in an Office Action mailed July 6, 2006 ("Final Office Action"), which finally rejected all

claims in the above-identified utility patent application, and further in view of the

decision from a pre-appeal brief conference request for review, the response to which was

mailed March 9, 2007.

Based on the arguments presented in the Appellant's Appeal Brief of

October 3, 2007 (hereinafter "Appeal Brief") and herein, the Appellant again requests that

the Board of Patent Appeals and Interferences order that the final rejection of Claims 1-39

be withdrawn, that Claims 1-39 be confirmed as patentable, and that a certificate be

issued confirming patentability.

So as not to burden the Board by repeating arguments contained in the

Appeal Brief, the Appellant incorporates and maintains herein all of the arguments

presented in the Appeal Brief by reference. The following remarks, for the most part, are

limited to a rebuttal of the issues and inaccuracies raised by the Examiner's Answer.

RESPONSE TO THE REJECTIONS UNDER 35 U.S.C. §103

I.   **Claims 1 and 37-39 Are Non-Obvious:**

   A.   **The Combination of Doi and Lunsford Still Do Not Render Obvious
            the Subject Matter of Claim 1 as a Whole**

In Section VII(A)(1) of the Appeal Brief, the Appellant argued that the

combination of the cited references Doi (US 2001/0014911) and Lundsford (US

6,982,962) would not result in the combination of claim 1. For example, Doi describes a

system in which a user through a mobile terminal is able to obtain *already known*

services, such as a user non-identification or identification service, from a service

provider across a network connection via the Internet. Lunsford simply deals with

establishing a network connection, rather than with services available across the

connection (e.g., Internet) such as in Doi or the recognition of such services. As a

consequence, the resulting system or method from the teachings of these two references

would simply allow the mobile terminal of Doi to be able to detect and select a network

access or network access provider (as taught in Lunsford) to access the Internet and

thereafter through the selected network access send a service request to the already known

service provider (and its services) as in Doi across the Internet. Accordingly, the

resulting combination still would neither disclose (1) the claimed recognizing operation

nor (2) the operations of the recognizing, determining and conducting being performed

with respect to the same service operator or service opportunit(ies).

The Examiner's Answer attempts to side step the merits of these

arguments through a general allegation that the Appellant is addressing the references

separately.

> Appellant argues, in substance, that (A.1) the combination
> of Doi in view of Lunsford do not render obvious the
> subject matter of claim 1 as a whole. The Examiner
> disagrees. Appellant argues the teachings of Doi and
> Lunsford separately instead of the combination as described
> in the rejections above. Appellant is aware that one cannot
> show non-obviousness by attacking references individually
> where the rejections are based on combinations of
> references. See In re Keller, 642 F .2d 413, 208 USPQ 871
> (CCPA 1981); In re Merck & Co., 800 F.2d 1091,231
> USPQ 375 (Fed. Cir. 1986). The combination as described
> above clearly teaches claim 1 as a whole and therefore
> should be maintained.

(Examiner's Answer, p. 13)

Clearly, that is not the case. The Appellant's arguments as set forth above and in the

Appeal Brief not only address the teachings of the references together but also discuss in

greater detail the teachings of each of these cited references in their proper context as

would be understood by one or ordinary skill in the art.

B.   **The Rejection of Claim 1 Lacks Any Rational Underpinning to
       Support the Legal Conclusion of Obviousness**

In reply to the Appellant's arguments set forth in Section VII(A)(2) of the

Appeal Brief, the Examiner in the Examiner's Answer replies as follows:

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Appellant argues, in substance, that (A.2) the rejection of claim 1 lacks any rational underpinning to support the legal conclusion of obviousness. The Examiner disagrees. As stated in the Advisory Action, Lunsford would receive the services provided by the service provider via an inquiry page which is conducted anonymously (Lunsford: col. 5, lines 32-50). The user of the PID also establishes particular preferences for the access providers, including security preferences (e.g. abstract; Figure 6, ref. 420). Once the particular access points are ascertained based on the user's preferences, a user can establish a connection at the obtained security level (i.e. privacy level). ***Based on this security level ascertained by the inquiry page of Lunsford, the users profile information can be filtered via the profile filtering system (Figure 12; ~ 69)*** of Doi to coincide with the requirements of the selected access provider. It would have been obvious to one of ordinary skill in the art combine the teaching of Lunsford with Doi since Lunsford describes a modification of a similar service access system, and therefore one of ordinary skill in the art would find it obvious to combine the teachings of Lunsford with the system of Doi in order to realize the benefits described in Lunsford with the system of Doi, namely the ability to simplify the user's experience of selecting an optimum network access provider (Lunsford: col. 1, lines 40-45).

(Examiner's Answer, pp. 13-14 (emphasis added))

The Examiner now appears to suggest that "security" or "security preferences" in Lunsford reads on the claimed privacy level (to be determined) of claim 1, and the ascertained security preference of Lundsford would be used to filter user profile information as allegedly taught by the profile system of Doi. However, Lundsford is silent as to what is meant by "security" preference[1] and thus there is nothing to indicate that "security" as discussed in Lundsford is related to control of user profile information or the like as in Doi as alleged by the Examiner. As best understood, in the field of

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[1]   It is respectfully noted that Lundsford is silent as to the term or phrase a "security

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communications as in Lundsford, the term "security" appears to refer to how data is communicated (i.e., encryption) versus what data is communicated. This appears to be consistent with the other types of connection preferences, e.g., reliability of access, signal level, cost and ownership, described in Lundsford. All of these relate to characteristics of a communications connection. Therefore, it is respectfully submitted that one of ordinary skill in the art would not combine the references in the manner suggested by the Examiner, i.e., using the security preference as allegedly taught by Lunsford to filter user profile information as allegedly taught by Doi.

Further, the Examiner's Answer oversimplifies the nature of the services and systems of Lunsford and Doi. The Appellant respectfully disagrees with the Examiner's contention that "[i]t would have been obvious to one of ordinary skill in the art combine the teaching of Lunsford with Doi Lunsford describes a modification of a similar service access system." The Doi and Lundsford references are directed to different types of services and environments. Doi deals with service opportunities or services which may be accessed across a *network connection* (e.g., the Internet) via a request, whereas Lundsford deals with the detection and establishment of a *network connection*. As such, one of ordinary skill in the art would not conclude that Doi and Lundsford renders obvious the operations of the recognizing, determining and conducting as performed with respect to the **same** service operator or service opportunit(ies). Instead, as noted supra Section I(A), the resulting system or method from the teachings of these two references would simply allow the mobile terminal of Doi to be able to detect and

(..continued)
level" which is used to describe the alleged teachings of Lunsford.

select a network access or network access provider (as taught in Lunsford) to access the

Internet and thereafter through the selected network access send a service request to the

already known service provider (and its services) as in Doi across the Internet.

        Accordingly, the Examiner's rejection of claim 1 lacks any rational

underpinning to support the legal conclusion of obviousness.

        C.   **The Rejection of Claim 1 Would Render Doi Unsatisfactory for its Intended Purpose and Change its Principle Operation**

        In reply to the Appellant's arguments set forth in Section VII(A)(3) of the

Appeal Brief, the Examiner in the Examiner's Answer replies as follows:

> Appellant argues, in substance, that (A.3) the rejection of claim 1 would render Doi unsatisfactory for its intended purpose and change its principle operation. The Examiner disagrees. The principle operation, contrary to Appellant's belief, is to providing various services to a mobile user (p. 1, ll 1). The incorporation of Lunsford merely eases the establishment of a connection to a network access server to access these particular services. Lunsford does not prevent the service providers of Doi from providing services to the mobile user, rather they would help the user establish a connection to the service providers. By this rationale, the combination of Lunsford with Doi would not change the principle operation of Doi, and therefore the rejection should be maintained.

        (Examiner's Answer, pp. 14-15)

The Appellant respectfully disagrees.

        The Examiner has over generalized the principle operation of Doi,

particularly as to the features upon which the Examiner relies upon for his rejection. The

feature of Doi relied upon by the Examiner is not simply the provision of services, but

more importantly the control over user profile information, e.g., User ID, for privacy. As

noted in Doi, "[i]t is another object of the present invention to provide a service providing

system for *anonymously* presenting a user of the mobile terminal to a service." See Doi,

para. [0009] (emphasis added). Thus, interpreting the network access provider and the

service providing server to be the same service operator would indeed be contrary to the

privacy arrangement as claimed as well as in Doi since the operator of the "access point"

or network access actually receives the User ID.

In view of at least the reasons in the Appeal Brief and set forth above in

Sections I(A) through I(C), the Appellant respectfully submits again that claim 1 and its

dependent claims are distinguishable over the cited references, individually or in

combination. For similar reasons, claims 37-39 and their dependent claims are also

believed to be distinguishable over the cited references, individually or in combination.

II.   Claim 34 Is Non-Obvious:

In reply to the Examiner's Answer on page 15 addressing the Appellant's

arguments set forth in Section VII(B) of the Appeal Brief, the Appellant respectfully

submits that claim 34 and its dependent claims are still believed to be distinguishable

over the cited references, individually or in combination, for similar reasons in the Appeal

Brief and as discussed above with respect to claim 1.

Further, for the reasons set forth in the Appeal Brief and set forth below

with reference to claim 21, the cited references also do not disclose or suggest

transmitting the profile access level to the service operator; and enabling the service

operator to obtain a subset of profile information of the user from a profile operator
according to the profile access level, as recited in claim 34.

Accordingly, claim 34 and its dependent claims are distinguishable over
the cited references.

III.   Dependent Claims 4-9 Are Non-Obvious:

In reply to the Examiner's Answer on pages 15-16 addressing the
Appellant's arguments set forth in Section VII(C) of the Appeal Brief, the Appellant
respectfully submits that claims 4-9, which depend directly or indirectly from
independent claim 1, are distinguishable over the cited references for at least the same
reasons set forth for claim 1 in the Appeal Brief and herein.

IV.   Dependent Claim 21 Is Non-Obvious:

In reply to Appellant's arguments set forth in Section VII(D) of the Appeal
Brief, the Examiner in the Examiner's Answer replies as follows:

> Appellant further argues, in substance, that (D) dependent
> claim 21 is non obvious. The Examiner disagrees. The
> dynamic user profile of Doi is construed as the "subset of
> profile information" (it is a subset because the dynamic
> does not include the static user profile information). The
> mobile device already knows whether or not a particular
> server is a location-dependent service providing server or a
> location independent service providing server, and
> therefore knows which subset of the profile information to
> send to the particular service providing server. When taken
> in context with Lunsford, the anonymous inquiry message
> would gather the security profile information needed for
> each of the devices in range, and therefore when the user
> communicates with one of these devices, will be able to
> determine which subset of profile information would be
> shared with the particular device. By this rationale the

rejection should be maintained.

(Examiner's Answer, p. 16)

The Examiner now clarifies that the dynamic user profile of Doi is being construed as the "subset of profile information", but still does not indicate how the references are now relied upon to show the profile access level which is transmitted to the service operator and used by the service operator to obtain a subset of profile information from a profile operator as required by claim 21. The Examiner's Answer remains vague as to how the cited references render obvious the profile access level, its transmission to the service operator and its use by the service operator to obtain a subset of profile information. Thus, the cited references do not show each and every limitation of claim 21.

Further, the Appellant respectfully submits that claim 21, which is dependent upon base claim 1, is also not rendered obvious by the cited references for at least the reasons set forth above for independent claim 1.

V.   Dependent Claim 23 Is Non-Obvious:

In reply to the Examiner's Answer on pages 16-17 addressing the Appellant's arguments set forth in Section VII(E) of the Appeal Brief, the Appellant respectfully submits that claim 23, which depends from intervening claim 21 and base claim 1, are distinguishable over the cited references for at least the same reasons set forth for claims 1 and 23 in the Appeal Brief and herein.

VI.   Dependent Claim 27 Is Non-Obvious:

In reply to the Examiner's Answer on pages 17-18 addressing the Appellant's arguments set forth in Section VII(F) of the Appeal Brief, the Appellant respectfully submits that claim 27, which depends indirectly from base claim 1, are not rendered obvious by the cited references for at least the same reasons set forth for claim 1 in the Appeal Brief and herein.

VII.   Dependent Claim 28 Is Non-Obvious:

In reply to the Examiner's Answer on page 18 addressing the Appellant's arguments set forth in Section VII(G) of the Appeal Brief, the Appellant respectfully submits that claim 27, which depends indirectly from base claim 1, are not rendered obvious by the cited references for at least the same reasons set forth for claims 1 in the Appeal Brief and herein.

VIII.   Dependent Claim 36 Is Non-Obvious:

In reply to Appellant's arguments set forth in Section VII(H) of the Appeal Brief, the Examiner in the Examiner's Answer replies as follows:

> Appellant argues, in substance, that (H) dependent claim 36 is non-obvious. The Examiner disagrees. Doi-Lunsford discloses a user device detecting a plurality of network access providers according to security requirements (Lunsford: e.g. abstract). Doi also discloses determining what information from the user is sent to the particular server based on what type of profile the server requires (see rejections above). Based on these two teachings, one of ordinary skill in the art would be able to utilize the profile filtering techniques disclosed in Doi with the security requirements described in Lunsford in order to provide efficient communication over the network based on the

security requirements of the network. For these reasons the
rejection should be maintained.

(Examiner's Answer, p. 18)

The Appellant respectfully disagrees. The Examiner still does not address the specific

language of the claims, namely that the user device controls what information is sent from

the user device according to the privacy level. That is, as claimed, the user device

controls what information is actually or is to be sent from the user device.

Lunsford is silent as to the user device controlling what information is sent

from the user device according to the privacy level. The Examiner appears to rely on Doi

as remedying this deficiency in the Lunsford teaching. However, as described in Doi, the

wireless gateway 19 receives User ID, static profile and dynamic profile and selectively

provides this information to the servers based on the communication control information

table. See Doi, paras [0062]-[0063]. The alleged "filtering" as termed by the Examiner

is performed by a system, e.g., gateway 19, other than the user device. Accordingly, the

combination of Doi and Lundsford is also silent as to the user device controlling what

information is sent from the device according to the privacy level.

Further, the Appellant respectfully submits that claim 36, which is

dependent upon base claim 1, is also not rendered obvious by the cited references for at

least the reasons set forth above for independent claim 1.

In view of the foregoing, dependent claim 36 is further distinguishable

over the cited references, individually or in combination.

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CONCLUSION

For the above reasons, the Appellant respectfully asserts that the rejection

of claims 1-39 under 35 U.S.C. §103(a) is improper. Withdrawal of the rejection of the

claims under 35 U.S.C. §103(a) is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees

which may be required for consideration of this Amendment to Deposit Account No. 13-

4500, Order No. 4208-4007.

In the event that an extension of time is required, or which may be

required in addition to that requested in a petition for an extension of time, the

Commissioner is requested to grant a petition for that extension of time which is required

to make this response timely and is hereby authorized to charge any fee for such an

extension of time or credit any overpayment for an extension of time to Deposit Account

No. 13-4500, Order No. 4208-4007.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: February 8, 2008   By: _____

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